REMARKS

Applicants acknowledge receipt of an Office Action dated February 11, 2008. In this response, Applicants have amended claim 1. Support for the claim amendments can be found in the specification as originally filed, *inter alia*, in original claim 2, on page 5, lines 1-3, and on page 7, lines 7-12. Following entry of these amendments, claims 1 and 5-9 are pending in the application. Claims 7 and 8 have been withdrawn from consideration. Thus, claims 1, 5, 6, and 9 are currently pending and under consideration.

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Comments on Examiner's Note

On page 2 of the Office Action, the PTO notes that "L" is a measure of lightness versus darkness and cloudiness, with higher "L" values having greater lightness or clearness. The PTO also notes that "a" and "b" are measures of color. Applicants respectfully disagree with the PTO's interpretations.

Applicants note that the application as originally filed provides that the CIE LAB color space is utilized for CIE calorimetric system L*a*b* rather than the Hunter color values as interpreted by the PTO. Specification, page 2, line 25; page 4, lines 16-20. As known in the art, CIE LAB is the color space defined by the International Commission on Illumination. L* represents the lightness of the color, when L* = 0 yields black and when L* = 100 indicates diffuse white; a* negative values indicate green and positive values indicate magenta; b* negative values indicate blue and positive values indicate yellow.

Rejection Under 35 U.S.C. § 112, Second Paragraph

On page 2 of the Office Action, the PTO has rejected claims 1, 5, 6, and 9 under 35 U.S.C. 112, second paragraph, as allegedly being indefinite. In this response, Applicants have amended claim 1 to read "film thickness" in order to further clarify the term "thickness."

Rejection Under 35 U.S.C. § 103

On page 3 of the Office Action, the PTO has rejected claims 1, 5, and 9 under 35 U.S.C. § 103(a) as being allegedly unpatentable over EP 0148718A2 to Panush (hereafter "Panush") in view of U.S. Patent 6,291,018 to Dattilo (hereafter "Dattilo"). In addition, on

page 6 of the Office Action, the PTO has rejected claim 6 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Panush in view of Dattilo, further in view of U.S. Patent 5,962,574 to Jackson *et al.* (hereafter "Jackson"). Applicants respectfully traverse this rejection for at least the reasons set forth below.

The framework for the objective analysis for determining obviousness under §103 requires:

1. Determining the scope and content of the prior art;
2. Ascertaining the differences between the claimed invention and the prior art;
3. Resolving the level of ordinary skill in the pertinent art; and
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Teleflex, Inc. v. KSR Int'l Co., 127 S. Ct. 1727, 82 USPQ2d 1385 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). In order to establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See MPEP §2143.03.

Here, Panush, Dattilo, and Jackson, whether taken individually or in combination, fail to teach or suggest a method "wherein the clear paint coating is a transparent coating and does not contain a color pigment" as recited in claim 1.

Panush actually teaches away from the presently claimed invention. Panush teaches that color "pigments can be used ... in the primer layer, base coat, and/or topcoat." Panush, page 5, lines 16-20. Panush further provides that "[u]sing a color tinted clear coat significantly reduces the penetration of solar energy and moisture, providing an intermediate that absorbs, reflects, and refracts solar energy and moisture ... and result[s] in lower and reduced ultraviolet rays reaching the base coat." Panush, page 7, lines 53-61. Furthermore, because of the color tinted clear coat of Panush, "it is possible to produce base coat colors using less durable and less costly pigments. Panush, page 7, lines 62-65.

The presently claimed method recites that "the clear paint coating is a transparent coating and does not contain a color pigment." This is particularly advantageous in the presently claimed invention because it obtains enough glitter of the effect pigment contained in the base paint. If the clear paint coating were to contain white color pigment such as disclosed in Panush to increase the opacity of the clear paint, the glitter effect of the base

paint would be obscured by the clear paint. The addition of the color pigment to the clear paint deteriorates the glitter of the effect pigment, resulting in a negative effect on the design of the coating.

Datillo teaches "[a]pplying the effect pigment-containing second basecoat layer over the first basecoat layer ... permit[s] the effect pigment in the second basecoat layer to correctly orient. Datillo, Col. 9, lns. 3-9. However, Datillo fails to teach or suggest a method "wherein the clear paint coating is a transparent coating and does not contain a color pigment" as recited in claim 1.

Jackson discloses a "sprayable, solvent-borne, primer composition ... overcoated wet-on-wet with automotive topcoat finishes and cured simultaneously in a single bake." Jackson, Abstract. However, Jackson fails to teach or suggest a method "wherein the clear paint coating is a transparent coating and does not contain a color pigment" as recited in claim 1.

For at least this reason, Applicants submit that the outstanding rejection based upon the combination of Panush, Dattilo, and Jackson does not properly apply to the currently pending claims and ought to be withdrawn.

If an independent claim is nonobvious under § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). See MPEP 2143.03. Thus, Applicants submit that claims 5, 6, and 9, each of which ultimately depends from independent claim 1, are also non-obvious at least by virtue of their dependency from claim 1.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under § 103.

CONCLUSION

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or

even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 5/12/08 By _____

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